REMARKS

1.   Applicant thanks the Examiner for the Examiner's remarks and observations, which have greatly assisted Applicant in responding.

2.   **35 U.S.C. § 101**

Claims 1-18 stand rejected under 35 U.S.C. § 101.   Responsive thereto, Applicant amends claim 1 to describe "means for setting up a matter file . . . " and an "attribute assignment component."   Support for the amendment is found in original claims 1 and 16, Figure 3, and paragraphs 118 to 126 of the published application. Additionally the logic elements described in claims 2-15 have been stricken from the claims and replaced with the expression "component." Support for the amendments is as above.   As amended, claim 1 and dependents describe a DMS that is linked to a practical result in the technology arts, creation of a matter file, and assignment of metadata to documents filed in the folders of the matter file.

Claim 16 has been amended to make it clear that a computerized method is being described.   Accordingly, as amended, claim 16 describes statutory subject matter.   Additionally, claims 16-18 produce a concrete result in the technology arts: creation of a matter file and assignment of metadata to documents filed in the folders of the matter file.

Accordingly, the rejection of claim 1-18 under 35 U.S.C. § 101 is deemed to be overcome.

3.   **35 U.S.C. § 102**

Claims 1-5, and 8-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. published application no. 2003/0217034 ("Shutt").   Applicant respectfully disagrees.

The Examiner relies on paragraph 0166 of Shutt as teaching "a matter file including a plurality of folders, each folder corresponding to a document type." The cited paragraph describes Shutt's table 172 "FOLDER_DOCUMENTS." As described in the cited teaching, one document attribute is DOC_TYPE, which identifies the

document's classification within the folder (line 8). The DOC_TYPE must be a valid member of the document type list associated with the folder. Thus, the party creating the folder can specify a list of document types which the folder will accept. However, there is no teaching in Shutt of "a matter file including a plurality of folders, each folder corresponding to a document type." Instead, multiple documents of varying type are all placed within the folder, not in sub-folders according to type. As described in para. 84 of Shutt, the party creating the folder can define different views for the folder, however there is no teaching or suggestion in Shutt that the party creating the matter file can create individual folders within the matter file, each dedicated to a different document type. There is, therefore, no anticipation of the claimed invention by Shutt. Accordingly, the present rejection is deemed to be improper.

Claim 4: The Examiner relies on paragraph 0818 of Shutt as teaching "matter creation logic to create a new matter folder, the matter creation comprising: matter type logic to receive a matter type selection from a user, and to create a plurality of folders with the new matter folder, each folder corresponding to a document type." As above, Shutt does allow the user to specify the document types a folder will accept, but there is no teaching in Shutt of "and to create a plurality of folders with the new matter folder, each folder corresponding to a document type."

Claim 8: The Examiner relies on paragraph 0082 of Shutt as teaching "a subscription logic to enable a user to subscribe to a matter file, the subscription putting a copy of a matter file in the user's 'My Matters' list." The cited teaching describes the use of predefined field format lines by the user to define attributes for a folder. Thus, what is being described is definition of the attributes for a folder. It has nothing at all to do with allowing a user to subscribe to a matter file and placing the file in a customized list in the user's workspace.

Claim 9: The Examiner relies on paragraph 0104 of Shutt as teaching "the subscription logic enables a user to subscribe to a matter file at a second level, wherein the subscription includes the matter file and documents and other folders." In fact, the cited teaching has nothing to do with subscription at all. The cited teaching indicates that, if a user attempts to take actions other than those he is authorized to take, the system displays a notification that he has insufficient authority to take such action and

does not permit the action. Thus, the cited teaching appears to teach the opposite of the subject matter of the claim.

Claim 10: The Examiner relies on paragraph 0101 of Shutt as teaching "where the subscription logic enables a user to subscribe to another user's subscription list and the user may be granted rights to modify another user's subscription list." While Shutt does teach that a user may be granted rights to a folder, including removing a document from a folder, it does not teach or suggest subscribing to another users subscription list, or modifying another user's subscription list.

Claim 11: The Examiner relies on paragraph 0112 of Shutt as teaching "an email logic to file emails in an appropriate matter file." The cited teaching actually describes sending email notifications to specified users when the folder receives documents of a specified type.

Claim 12: The Examiner relies on Figure 17 of Shutt as teaching "email logic to prompt a user to send a copy of an email to the matter folder." What is shown is a directive to send notification if documents do not appear in the folder by a predetermined date and time. There is suggestion of prompting a user to send a copy of an email to the matter folder for filing.

Claim 13: The Examiner relies on Figure 1 of Shutt as teaching "matter file logic to arrange the matter file into a taxonomy based on the metadata of the matter file." In fact, Figure 1 has nothing to do with taxonomies or folders or matter files. Figure 1 and the accompanying text describe a typical mortgage transaction. Figure 1 illustrates the documents and parties involved in the transaction. There is no teaching or suggestion of a taxonomy.

4.   **35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some <u>suggestion or motivation</u>, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a <u>reasonable expectation of success</u>. Finally, the prior art <u>reference (or references when combined) must teach or suggest all the claim limitations</u>. MPEP § 2143.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shutt in view of in view of U.S. Patent No 6,401,097 ("McCotter") and further in view of U.S. Patent No. 6,269,369 ("Robertson"). In view of the above, the present rejection is deemed to·be improper.

5   Even if Shutt stood for what the Examiner holds it to stand for, the present rejection would still be improper because the Examiner, in combining the teachings of Shutt and McCotter has formulated the rejection incorrectly. There is no indication of which teachings from McCotter the Examiner is relying on. Additionally, the Examiner has failed to describe a motivation for combining McCotter with Shutt. Moreover, the

10   Examiner has failed to establish a reasonable expectation of success from the combination. On these grounds alone, the present rejection is improper.

The Examiner relies on fig. 10 and col. 8, lines 10-30 of Robertson as teaching "an email interface to generate an email address for the matter folder, the email address to receive emails and file them in a correspondence folder in the matter folder."

15   While it is impossible to fully discuss the substantive aspects of the rejection due to the Examiner's failure to discuss McCotter fully, Applicant notes that Robertson describes a networked address book. Figure 10 shows the user interface to Robertson's address book. The cited text describes the ability of the address book owner to grant permission to others to use the address book by emailing them a <u>link</u>. Thus, Robertson does not

20   describe creating an email address for a database, for the purpose of sending emails to the database. Rather, Robertson describes emailing a hyperlink so that the person being granted permission can access the address book by activating the hyperlink. Accordingly, the combination fails to teach or suggest all elements of the claimed invention. Even if the combination did teach all elements of the claimed invention, the

25   Examiner has failed to establish a motivation for making the combination, instead relying on a conclusory statement that the combination would be obvious, without providing any further explanation. Even if the Examiner had established a motivation, the Examiner has failed to establish a reasonable expectation of success from the combination. Accordingly, the present rejection is deemed to be improper.

30   Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shutt in view of McCotter and further in view of U.S. Patent No. 5,864,865

("Lakis"). Applicant respectfully disagrees. In view of the above remarks regarding claim 1, the current rejections of both claims 14 and 15 are deemed to be improper. Even if Shutt stood for what the Examiner holds it to stand for, the present rejections suffer the same type of defects as the preceding rejection of claims 6 and 7. The Examiner fails to identify any teaching from McCotter, and fails to state a motivation for combining Shutt and McCotter. Additionally, the Examiner has failed to establish a reasonable expectation of success from the combination. Therefore, on each of these separate grounds, the present rejection of each of claims 14 and 15 is improper.

Claims 1-5, and 8-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,571,245 ("Huang") in view of McCotter. Applicant respectfully disagrees.

The Examiner relies on Huang, col. 14, lines 40-50 as teaching a matter file including a plurality of folders, each folder corresponding to a document type." Huang describes a virtual desktop for a computer network. The cited teaching has nothing to do with a matter file. What is described is a customization window. Icons are displayed to the user, and the user is able to select from the icons to associate an icon with a selected object. Thereafter, clicking on the icon launches the associated object. Additionally, the customization window contains an item description listing which lists items that are associated with the object. The window also contains a query box that allows the user to search for particular items. Thus, Huang's invention allows the user to associate a plurality of objects to a single icon. There is, however, no teaching or suggestion of "a matter file including a plurality of folders, each folder corresponding to a document type" in the cited teaching from Huang. McCotter adds nothing to Huang.

The Examiner next relies on McCotter as teaching "an attribute assignment logic to automatically create metadata data fields for a new document, when the new document is placed in a folder, the metadata fields appropriate for the document type." McCotter describes a system and method for integrated document management. While McCotter describes creation of an object profile (Abstract), the cited teaching (col. 3, lines 10-15) is nothing more than a general description of what metadata are. The cited teaching does not teach or suggest "attribute assignment logic to automatically create metadata data fields for a new document, when the new document is placed in a folder,

the metadata fields appropriate for the document type." Huang adds nothing to McCotter. The combination therefore fails to teach or suggest all features of the invention. On this ground alone, the present rejection is deemed to be improper.

Additionally, the Examiner has failed to establish a motivation for making the combination, beyond a conclusory statement that it would have been obvious to make the combination. On this ground alone, the present rejection is deemed to be improper.

Additionally, the Examiner has failed to establish a reasonable expectation of success from the combination. On this ground alone, the present rejection is deemed to be improper.

Additionally, the Examiner mentions a third reference, Terek, without any further information or explanation. On this ground alone, the present rejection is deemed to be improper.

Accordingly, claim 1 is deemed to be allowable over the combination. In view of their dependency from an allowable parent, the dependents are also deemed to be allowable without any separate consideration of their merits. Nevertheless, Applicant provides the following comments regarding the independent claims:

Claim 2: The Examiner relies on Huang as teaching "metadata copying logic to automatically fill in the metadata fields which correspond to metadata fields in a parent folder." What is shown is a flow diagram of updating the files in a sync folder. Applicant fails to see the relevance to the claimed invention.

Claim 4: The Examiner relies on Huang, Fig. 6, and col. 9, lines 5 -15 of Huang as teaching "a matter creation logic to create a new matter folder, the matter creation comprising:

matter type logic to receive a matter type selection from a user, and to create a plurality of folders within the new matter folder, each folder corresponding to a document type." What is described and depicted is a conventional process for creating and copying folders on a virtual desktop. There is no teaching or suggestion of "matter type logic to receive a matter type selection from a user, and to create a plurality of folders within the new matter folder, each folder corresponding to a document type."

Claim 5: The Examiner relies on col. 8 line 55 to col. 9, line 6 as teaching "a work list logic to receive a list of users for the new matter folder, and to add the new

matter folder to a My Matters folder for the list of users." While the cited teaching describes a user information database, a user file database, access control and file sharing there is no teaching of the above features in the cited teaching.

Claim 8:   The Examiner relies on claim 8 of Huang as teaching "a subscription logic to enable a user to subscribe to a matter file, the subscription putting a copy of a matter file in the user's My Matters list." Figure 8 shows the operation of a file synchronization application the synchronizes the files in a synchronization folder on each of the user's virtual desktop, the office desktop and the home desktop.

Claim 10:   The Examiner relies on Huang, col. 14, lines 55-65 as teaching "the subscription logic enables a user to subscribe to another user's subscription list and the user may be granted rights to modify another user's subscription list." The cited teaching merely notes that the user is allowed, to a certain extent, to choose the level of security to be maintained. The paragraphs following the cited teaching in col. 15 describe Huang's security features in greater detail. There is no teaching or suggestion of the subject matter of claim 10 in these paragraphs.

Claim 11: The Examiner relies on Huang, Figure 14 as teaching: "an email logic to file emails in an appropriate matter file." As above, Figure 14 is a flow diagram of a file synchronization process. While it may be true that files are transferred during synchronization, there is no teaching in Figure 14 of "email logic to file emails in an appropriate matter file."

Claim 12:   The Examiner relies on Huang, Figure 9 and 14 as teaching "email logic to prompt a user to send a copy of an email to the matter folder." Again, the Figures describe file synchronization. While files may be transferred, there is no suggestion that they are emailed. Additionally, the process of synchronization is automated. Therefore there is no suggestion of "prompt a user to send a copy of an email to the matter folder."

Claims 6-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of McCotter and further in view of Robertson. In view of the above remarks concerning claim 1, the present rejection is deemed to be improper. Additionally, however, The Examiner relies on fig. 10 and col. 8, lines 10-30 of Robertson as teaching "an email interface to generate an email address for the matter

folder, the email address to receive emails and file them in a correspondence folder in the matter folder." As above Applicant notes that Robertson describes a networked address book. Applicant's previous remarks regarding Robertson are equally relevant to the present rejection. Accordingly, the combination fails to teach or suggest the elements of the claimed invention. Even if the combination did teach all elements of the claimed invention, the Examiner has failed to establish a motivation for making the combination, instead relying on a conclusory statement that the combination would be obvious, without providing any further explanation. Even if the Examiner had established a motivation, the Examiner has failed to establish a reasonable expectation of success from the combination. Accordingly, the present rejection is deemed to be improper.

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of McCotter and further in view of Lakis. In view of the above remarks regarding claim 1, the present rejection is deemed to be improper.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCotter in view of U.S. Patent No. 6591,289 ("Britton").

As discussed above with respect to claim 1, there is no teaching or suggestion in McCotter of "setting up a matter file in response to a user request, the matter file including the plurality of folders; and

automatically creating metadata data fields for a new document filed in one of the plurality of folders in the matter file, the metadata fields appropriate for the document type."

The Examiner relies on Britton, col. 9, lines 45-65 as teaching "having a plurality of templates, each template designed to set up a matter file including a plurality of folders, each folder corresponding to a document type." Applicant respectfully disagrees. The cited teaching from Britton does teach provision of a type of template. Beyond that, the cited teaching offers no details of the features of said templates, other than that they are report templates. The present invention has nothing to do with report templates. There is, therefore, no teaching or suggestion in Britton of "each template designed to set up a matter file including a plurality of folders, each folder corresponding to a document type." Therefore, the present rejection is deemed to be improper.

In view of their dependency from an allowable parent, the dependents are deemed to be allowable without any separate consideration of their merits.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shutt in view of Britton and further in view of Lakis.
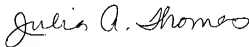
As applicant has previously discussed, Shutt does not describe a matter file that includes a plurality of folders. As previously discussed above, Britton does not describe "having a plurality of templates, each template designed to set up a matter file including a plurality of folders, each folder corresponding to a document type." Therefore, the combination fails to teach or suggest all features of the claimed invention. On this ground alone, the present rejection is deemed to be improper. Additionally, the Examiner fails to establish a reasonable expectation of success from the combination.

Claims 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shutt in view of Britton and further in view of Lakis. In view of the above, the present rejection is deemed to be improper.

CONCLUSION

Based on the foregoing, the Application is deemed to be in allowable condition. As such, Applicant earnestly requests reconsideration and prompt allowance of the claims. Should the Examiner deem it helpful, the Examiner is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,

Julia A. Thomas

Julia A. Thomas
Reg. No. 52,283

Customer No. 22,862